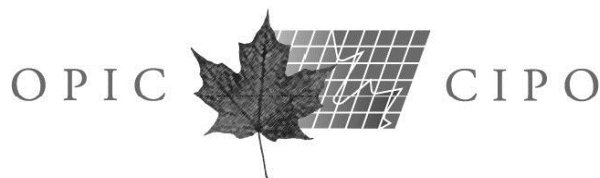


TRADUCTION/TRANSLATION



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 215
Date of Decision: 2011-11-07

**IN THE MATTER OF THE OPPOSITIONS by
1550581 Ontario Incorporated, operating as Trio, to
applications No. 1,339,347 and No. 1,339,378 for the
trade-marks NOVOTEL TRIO WINE FOOD
PLEASURE & Design and NOVOTEL TRIO VIN
SAVEUR PLAISIR & Design in the name of
ACCOR, société anonyme**

[1] On March 14, 2007, ACCOR, société anonyme, (the Applicant) filed applications for registration concerning the trade-marks NOVOTEL TRIO WINE FOOD PLEASURE & Design and NOVOTEL TRIO VIN SAVEUR PLAISIR & Design (the Marks) respectively, reproduced below, on the basis of proposed use of the Marks in Canada in association with the following wares and services (as amended during examination of each of the applications):

Application No. 1,339,347



Application No. 1,339,378



[TRANSLATION]

Paper and cardboard (raw, semi-finished or for stationery or printing); print products, including: newspapers, magazines, brochures, flyers, menus; blocks of paper; paper or paperboard signs; boxes, paper and sachets for packaging made of paper or plastic material; printed matter and print advertising, including: printed documents on tourism and travel, including pamphlets, newspapers, periodicals, brochures, flyers, prospectuses on tourism and travel, pamphlets, newspapers and periodicals all relating to the hotel, food services and travel industries; writing paper; postcards; business cards; posters and advertising posters; prospectuses, leaflets, magazines; books, albums and calendars; writing and drawing supplies, including: pens, chalk, writing pads, crayon sets, brush sets, drawing kits, erasers, lead holders, pen holders, drawing rulers, stamp pads, painting boxes, desk pen sets, document sleeves, paper, paint brushes, watercolours, drawing rulers, erasers, charcoal, pastels, sanguine pencils, oil paint, acrylic paint, gouache, drawings, decal printings, packing paper; printing plates; photographs; type.

Travel information (travel or tourism agencies, reservations); vehicle rental; excursion planning; cruise planning; tour planning; touristic visits; traveller accompaniment; vehicle garages; garage rental; warehouse rental; hotel and food services; temporary lodgings; motel, restaurant, cafeteria, tea room, bar (with exception of clubs) and guest house services; traveller hotel room reservation services; housing agencies (hotels, boarding houses); hotel reservations; temporary lodging reservations; boarding house and guest house reservations.

[2] The applications were advertised for opposition purposes in the *Trade-marks Journal* of March 5, 2008.

[3] On August 5, 2008, 1550581 Ontario Incorporated, operating as Trio, (the Opponent) filed a statement of opposition to each of these applications. The grounds of opposition can be summarized as follows:

1. The applications do not fulfill the requirements of s. 30(i) of the *Trade-marks Act* (R.S.C., 1985, c. T-13) (the Act) in that the Applicant could not have been satisfied that it was entitled to use the Marks in Canada in association with restaurant, cafeteria, tea room and bar services, having been notified on October 12, 2006, that the Opponent had been operating a bar/ restaurant under the name TRIO since October 2003;
2. Having regard to the provisions of ss. 16(3)(a) and (c) of the Act, the Applicant is not a person entitled to secure registration of the Marks in that, on the filing date of the

applications, the Marks were confusing with the trade-mark and trade-name TRIO previously used by the Opponent; and

3. The Marks are not distinctive of the Applicant's wares and services within the meaning of s. 2 of the Act in that neither are they adapted to distinguish nor do they actually distinguish these wares and services from the wares and services of the Opponent.

[4] The Applicant filed a counter statement in each file, denying all of the grounds of opposition.

[5] In support of each of its oppositions, the Opponent filed an affidavit sworn March 24, 2009, by Tracy Turnbull, the president, chief executive officer, secretary, treasurer and director of the Opponent. I will use the singular to refer to Ms. Turnbull's two essentially identical affidavits. In support of each of its applications, the Applicant filed an affidavit sworn October 14, 2009, by Josée Aubin, a trade-mark searcher in the research department of Onscope, a division of Marque d'Or Inc. I will also use the singular to refer to Ms. Aubin's two essentially identical affidavits.

[6] Each of the parties filed a written argument in each file. An oral hearing was not requested.

Analysis

Burden of proof

[7] The onus is on the Applicant to show that each of its applications complies with the requirements of the Act. However, the Opponent bears the burden of ensuring that each of its grounds of opposition is duly argued and of discharging its initial evidentiary burden by establishing the facts relied on to support its grounds of opposition. Once this initial evidentiary burden is met, it is up to the Applicant to establish, on a balance of probabilities, that none of these grounds of opposition impedes the registration of the Marks [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.); *Joseph E. Seagram & Sons Ltd. et al. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.); *Dion Neckwear Ltd. v.*

Christian Dior, S.A. et al. (2002), 20 C.P.R. (4th) 155 (F.C.A.); and *Wrangler Apparel Corp. v. The Timberland Company* (2005), 41 C.P.R. (4th) 223 (F.C.)].

Ground based on s. 16(3)(c) of the Act

[8] The Opponent can discharge its initial burden of proof with regard to this ground of opposition by establishing that its trade-name TRIO was used in Canada prior to the filing date of the applications and that it had not abandoned use of that trade-name at the date of advertisement of the applications [s. 16(5) of the Act]. This leads me to review Ms. Turnbull's affidavit.

[9] Ms. Turnbull states that the Opponent was incorporated on January 24, 2003, and that the trade-name TRIO was registered in Ontario on October 8, 2003. The Opponent began doing business under that name on October 8, 2003; this use has been continuous since that time, and the business has a good reputation among the restaurants in the city of Ottawa.

[10] In support of her statements, Ms. Turnbull filed the following documents:

- Exhibit "A": a copy of an advertisement in English, placed in the December 4 to 10 edition of the Ottawa newspaper *XPRESS*, advertising "TRIO", which is described as "a Montreal style bistro-lounge" located at 307d Richmond Road, showing in the background a photograph of the interior of the bistro bar;
- Exhibit "B": a copy of a similar advertisement in French, placed in the December 26, 2003, to January 7, 2004, edition of the Ottawa newspaper *Voir*;
- Exhibit "C": a copy of a review published in Anne DesBrisay's *DINING OUT* column in the April 24, 2004, edition of the *Ottawa Citizen* newspaper. Favourable on the whole, the column is given over exclusively to the Opponent's bistro bar "TRIO", located at 307d Richmond Road, and is sub-titled "Trio needs more creative kitchen";
- Exhibit "D": a copy of the "2005 Ottawa Magazine Restaurant Award" given to "Trio Bistro-Lounge", published in the *Ottawa Magazine*;
- Exhibit "E": a copy of a review published in Anne DeBrisay's *DINING OUT* column in the July 23, 2006, edition of the *Ottawa Citizen* newspaper. Favourable on the whole, the

column is given over exclusively to the Opponent's bistro bar "TRIO" located at 307d Richmond Road and is subtitled "Easy is affordable at neighbourhood eatery"; and

- Exhibit "F": a copy of an excerpt from the November 2006 edition of the *Ottawa Magazine* entitled "BEST RESTAURANTS by Chris Knight". The excerpt contains an article entitled "TEN DON'T-MISS RESTAURANTS – Ottawa Magazine's main reviewer picks 10 intriguing eateries", one of which is "Trio Bistro", located at 307d Richmond Road.

[11] Ms. Turnbull went on in her affidavit to describe the steps taken in respect of the Applicant after she became aware of an advertisement placed on October 4, 2006, in the *Ottawa Citizen* newspaper, announcing that, in early 2007, the Applicant intended to rename, as "TRIO", its restaurant "CAFÉ NICOLE" that operated inside the NOVOTEL hotel in downtown Ottawa. I will return below to these steps and to the research done by Ms. Turnbull on the subject over the years from 2006 to 2009. For the time being, it is sufficient to conclude that I am satisfied, on the basis of the evidence described above, that the Opponent has met its initial burden of proof regarding the use of the trade-name TRIO in association with the operation of its bistro bar. The Applicant must now show, on a balance of probabilities, that there is no likelihood of confusion between the Marks and the Opponent's trade-name.

[12] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that the use of a trade-mark is confusing with another trade-mark or trade-name if the use of both in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks or trade-names are manufactured, sold, leased, hired or performed by the same person, whether or not those wares or services are of the same general class.

[13] In deciding whether trade-marks are confusing, the Registrar must have regard to all of the surrounding circumstances, including those listed at s. 6(5) of the Act, namely (a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; (b) the length of time the trade-marks or trade-names have been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of

resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. This is not an exhaustive list, and different weight may be given to the each of these factors depending on the context [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401, (S.C.C.)].

(a) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known

[14] The Applicant's Marks consist, respectively, of the combination of the words NOVOTEL TRIO VIN SAVEUR PLAISIR with graphic elements and its English counterpart, consisting of the words NOVOTEL TRIO WINE FOOD PLEASURE in combination with the same graphic elements. By comparison, the Opponent's trade-name consists only of the word TRIO.

[15] The Applicant argues that the Marks, when considered in their entirety, contain numerous original elements limiting the potential for confusion with the Opponent's trade-name, including the following:

- [TRANSLATION] "the mark NOVOTEL, which belongs to a family of very well-known and very distinctive marks of which the Applicant is the owner". It should be noted immediately that the Applicant's allegations regarding the reputation of the mark NOVOTEL are not corroborated by of the any evidence in these files;
- the [TRANSLATION] "graphic arrangements"; and
- the [TRANSLATION] "descriptor[s] 'WINE [VIN], FOOD [SAVEUR], PLEASURE [PLAISIR]'".

[16] I will return to these elements later on in my assessment of the degree of resemblance between the Marks and the trade-name at issue.

[17] The Applicant also argues that the name TRIO, which constitutes the Opponent's trade-name, is not inherently distinctive. The Applicant refers me to the definitions of the word TRIO found in the dictionaries *Le Petit Robert* and *Le Grand Dictionnaire Terminologique*,

according to which TRIO is defined as a group of three persons and, in the [TRANSLATION] “packaging and conditioning” sector, as meaning the grouping in threes of the units of a product. The Applicant also refers me to the English-language dictionary *Merriam-Webster*, according to which TRIO simply means “a group or set of three”.

[18] The Applicant adds, on this point, that according to the online encyclopedia *Wikipedia*, a TRIO in the bar and food services industry means “a cocktail comprising a base spirit, a liqueur, and a creamy liquid”. The Applicant also submits that the word TRIO is commonplace in the food services and food industries. More specifically, the Applicant submits that, [TRANSLATION] “in the food services industry, a ‘trio’ is often a grouping of three food items (often a main dish, a side and a beverage) comprising a meal, which is sold ‘as a package’ by the restaurateur”. On this point, the Applicant refers me to the search report appended to Ms. Aubin’s affidavit, which reports on the trade-mark registrations recorded in the register of trade-marks. I will return to Ms. Aubin’s affidavit later on in my assessment of the additional circumstances that must be taken into account in these files.

[19] For its part, the Opponent submits the following at pages 4 and 5 of its written arguments:

The word ‘trio’ arises more naturally in some contexts than others; in the restaurant context, it is conspicuous. . . .

While ‘trio’ is a dictionary word with musical and numeric connotations, it is in no way descriptive of restaurant services or related wares. To the contrary, the word ‘trio’ is out of place in the restaurant context because restaurants do not call to mind anything pertaining to either the word ‘trio’ or the number three, as illustrated by the fact that the dictionary definitions provided under Tab ‘5’ of the Aubin affidavit mention music often but never food or related concept. . . .

Further evidence of the fact that ‘trio’ is an unusual word in the restaurant context can be found in the state of the register evidence provided under Tab ‘1’ of the Aubin affidavit, which shows that the word ‘trio’ appears in only four active third party entries relating to restaurants. . . .

[20] In my opinion, the inherent distinctiveness of the Opponent’s trade-name TRIO is partway between the parties’ contentions, that is, neither nonexistent, nor particularly strong. In fact, I am of the opinion that, in the context of the Opponent’s food services, the word TRIO

suggests the idea of a concept resting on three components. I note, to that effect, that the Opponent draws on that idea in its advertisements in stating “C’est toujours meilleurs à trois. Musique, boisson et conversation” (Exhibit “B”, referenced above) and “Good things come in 3’s. Music, drinks & conversation” (Exhibit “A”, also referenced above). The idea of a concept resting on three components is also taken up in the Applicant’s Marks through its inclusion of the words “WINE [VIN], FOOD [SAVEUR], PLEASURE [PLAISIR]”. On that basis, in my opinion, I must acknowledge that the Applicant’s Marks and the Opponent’s trade-name are inherently distinctive at an overall fairly low degree and to an approximately equivalent extent, although the inherent distinctiveness of the Marks is slightly greater given the presence of the word NOVOTEL, which has no particular meaning. This brings me to consider the second branch of s. 6(5)(a) of the Act, that is, the extent to which these trade-marks or this trade-name have become known.

[21] The strength of a trade-mark or trade-name may be increased as it becomes known through its promotion and use. In this instance, the Applicant has not filed any evidence of use of the Marks. As for the few pieces of evidence filed by the Opponent through Ms. Turnbull regarding the Applicant’s activities (discussed below), this evidence is insufficient for any conclusion whatsoever to be drawn concerning the extent to which the Marks have been used and become known in Canada.

[22] By comparison, and although Ms. Turnbull’s affidavit is not the most exhaustive, I am of the opinion that it is reasonable to conclude from the specimens of advertisements, reviews, awards and references described above (exhibits “A” to “F”) that the Opponent’s trade-name TRIO has been used continuously in association with the operation of a bistro bar in the city of Ottawa since at least December 2003 and that this bistro bar enjoys favourable reviews in that city. However, for lack of further details (such as sales figures, advertising figures, etc.) I am unable to determine whether the Opponent’s bistro bar is known to a substantial extent in Ottawa and outside of this city. For that reason, in my opinion, I must recognize that the Opponent’s trade-name TRIO has become known only to a certain extent in the city of Ottawa.

(b) The length of time the trade-marks or trade-names have been in use

[23] As shown by my review of the evidence above, this factor favours the Opponent.

(c) The nature of the wares, services or business; and (d) the nature of the trade

[24] The following services described in each of the applications, and the nature of the trade associated with those services, directly overlap the Opponent's services and the nature of its trade: "food services; restaurant, cafeteria, tea room, bar (with exception of clubs) services". As for the remaining services, with the exception of the wares described as "menus", I am of the opinion that it is reasonable to conclude that the Applicant's wares and services and the nature of the Applicant's trade associated with them differ from the Opponent's bistro bar and the nature of the Opponent's trade. Unlike the particular facts filed as evidence in *Ritz-Carlton v. Federal Diversiplex Ltd.* (1979), 59 C.P.R. (2d) 123 (T.M.O.B.), the evidence in these files does not allow me to conclude that there is any association whatsoever between the Opponent's bistro bar services and the remainder of the Applicant's wares and services.

(e) The degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them

[25] As noted by the Supreme Court in *Masterpiece Inc. v. Alavida Lifestyles Inc. et al.*, 92 CPR (4th) 361 at paragraph 49, the factor likely to have the most importance in the confusion analysis, and which is decisive in most cases, is the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

[26] Moreover, as mentioned above, it is well established in the case law that likelihood of confusion is a matter of first impression and imperfect recollection. In that respect, "[w]hile the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception of it" [see *Pink Panther Beauty Corp. v. United Artists Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.), at paragraph 34].

[27] Therefore, while in some cases the first word will be the most important element for the purposes of a trade-mark's or a trade-name's distinctiveness, the Supreme Court stated at paragraph 64 of *Masterpiece* that a preferable approach is to first consider whether there is an aspect of the trade-mark or trade-name that is particularly striking or unique.

[28] Applying these principles to the files at hand, I agree with the Opponent that the Marks and the trade-name at issue do resemble one another to a certain extent, in that the Marks emphasize the TRIO element which is prominently set out and reinforced by the numeral 3.

[29] In this respect, I agree with the Opponent that, in the context of food services, the words "WINE [VIN], FOOD [SAVEUR], PLEASURE [PLAISIR]" are descriptive or evocative in nature. Therefore, in my view it is reasonable to conclude that these elements would not be characterized as particularly striking or unique.

[30] As regards the "@ NOVOTEL" component, although in my view this part is unique and inherently distinctive, the evidence in the files leads me to accept the Opponent's argument that this component plays a secondary role. On this point, I wish to reproduce certain passages from the Opponent's written arguments, found at pages 9 and 10:

. . . the Opponent respectfully submits that the « @Novotel » element of the applied-for mark[s] is wholly inadequate for distinguishing the Applicant from the Opponent, even though the first element of a trade-mark is often the most important for the purpose of distinction.

On several occasions, the [Opposition] Board has considered how the public likely perceives a trade-mark composed of a proper noun (e.g. the applicant/registrant's surname or trade-name) as its first element, followed by a second element that is subsumed from a competing trade-mark. In such cases, the addition of such names, even as the first element of the impugned mark, may well be insufficient to distinguish that mark from those sharing the common element. In fact, the proper noun may well be perceived as a separate mark entirely.

. . .

In Esselte Pendaflex Canada Inc. v. Cherrigold Ltd. [(1987), 17 C.P.R. (3d) 312 (T.M.O.B.)] for example, the Board refused to register the mark CHERRIGOLD'S SUSPENDAFLEX on the basis that it was confusing with the mark PENDAFLEX, which the applied-for mark wholly subsumed. In so doing, the Board made the following comment:

. . . In the present case, the fact that the applicant’s mark comprises seven syllables increases the likelihood that the mark would be abbreviated when used. Furthermore, the fact that the first component of the applicant’s mark is in the possessive form and would likely be perceived as a surname would make it more likely that the mark would be abbreviated in use to the single word “suspendaflex”. It is also likely that the average consumer would perceive the first component of the applicant’s proposed mark as being the applicant’s house mark thereby further increasing the likelihood that any abbreviation of the mark would centre on the word “suspendaflex”. [Emphasis added by the Opponent]

The [Marks present] a very similar situation. « Novotel » is in fact the Applicant’s house mark. It is not in the possessive form, as in NOVOTEL’S TRIO, but the “@” symbol produces a similar effect; since “@” is vocalized as “at”, the applied-for mark conveys the message that “Trio” is located “at Novotel”, where wine, food, and pleasure is to be had.

As in the Suspendaflex case, moreover, “@NOVOTEL TRIO WINE FOOD PLEASURE” [@NOVOTEL TRIO VIN SAVEUR PLAISIR] is too unwieldy a phrase to serve as . . . effective trade-mark[s].

The natural tendency to abbreviate such trade-marks was also observed in Saga Enterprises, Inc. v. Glen Allen (1973) Ltd. [(1985), 5 C.P.R. (3d) 271 at 273 (T.M.O.B.)], where the Board said:

An average person having only a general but not a precise recollection of the opponent’s trade mark [STUART ANDERSON’S BLACK ANGUS] might only remember that it consists of the words “black angus” in combination with some design features. Bearing in mind the tendency to abbreviate, it would not be unexpected for an average person knowing the opponent’s restaurants to refer to them as the Black Angus restaurants.

Any doubt that remains as to how the public is likely to perceive the Applicant’s proposed [Marks] is easily resolved by reference to the [Marks’] design component, as well as the manner in which the [Marks have] been abbreviated to date.

[31] The Opponent continued its arguments on this point by referring to the evidence filed by Ms. Turnbull which pertains to the Applicant’s activities. More specifically, the Opponent pointed out that

- the *Ottawa Citizen* journalist who wrote the article mentioned above, in which was reported the Applicant’s intention to rename its restaurant “CAFÉ NICOLE” as “TRIO” in early 2007, refers to that restaurant simply by the name “TRIO” [Exhibit “G”];

- the same abbreviation was used by reviewer Anne Desbrisay in her column *DINING OUT*, published in the same newspaper in 2008, on the subject of the restaurant “TRIO RESTAURANT” located at “Novotel Hotel Ottawa, 33 Nicholas St.”, entitled “Three good reasons to avoid Trio Restaurant” [Exhibit “M”];
- the same abbreviation is found in the Yellow Pages telephone directory in the “Restaurants” section, in which are listed, one after the other, the Opponent’s and the Applicant’s restaurants as, respectively, “Trio 307d Richmond Rd” and “Trio Restaurant 33 Nicholas” [Exhibit “J”];
- the Applicant’s Web site, *www.novotelottawa.com*, refers to “Trio Restaurant” or even simply “Trio” (as an example, “At Trio, we’re reinventing the concept of dining by offering you an inventing selection of tasting-sized plates . . .”) [Exhibit “K”]; and
- although, according to Ms. Turnbull’s statements, the Marks are reproduced exactly as they appear on the outdoor signs of the Applicant’s restaurant, the “@NOVOTEL” component had been removed from the napkin rings found inside the Applicant’s restaurant at the time of Ms. Turnbull’s visit in March 2009 [Exhibit “L”].

[32] This leads me to return to the parties’ contentions regarding the distinctiveness of the word TRIO in the context of food services with regard to the evidence filed by way of Ms. Aubin’s affidavit.

Additional circumstances

State of the register and the marketplace

[33] The Applicant argues that [TRANSLATION] “. . . Ms. Aubin’s affidavit shows . . . that there are several trade-marks and several trade-names containing the word TRIO which coexist in the names of various owners in the register of trade-marks, (a number of which, that is, some twenty-odd, are used in the food services and restaurant industry)”.

[34] More specifically, the Applicant refers me to four trade-marks registrations for, among other things, food services, that is, registrations TMA534,744 and TMA531,555 for, respectively, the trade-marks SUBWAY TRIO POUR ENFANTS & Design and TRIO POUR

ENFANTS in the name of Doctor's Associates Inc. and registrations TMA682,263 and TMA538,883 for, respectively, the trade-marks HARVEY'S CUSTOM COMBO & Design and TRIO À VOTRE GOÛT in the name of Cara Operations Limited. I agree with the Opponent that this number is insufficient to draw conclusions regarding the state of the marketplace [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (C.O.M.C.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); and *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[35] With the exception of those four trade-marks registrations, it should be emphasized that the Applicant's contentions regarding the state of the register and the marketplace are in no way detailed. Although the Applicant refers to [TRANSLATION] "some twenty-odd" trade-marks or trade-names in the food and food services industries, the Applicant provides absolutely no clarification as to which trade-names it is referring from among the business names and trade-names listed in appendices 2 and 3 of the research report filed as Exhibit JA in support of Ms. Aubin's affidavit. I have no intention of undertaking a thorough review of these appendices, or of appendices 4 and 5 of the same report pertaining to domain names and to other references to the word TRIO from various sources, in order to try to find, somewhere among the 185 pages or so which make up this report, the supposed twenty-odd relevant trade-marks and trade-names. The onus is on the Applicant to substantiate its contentions in this regard [see *Novalab Inc. v. Lidl Stiftung & Co. Kg* (2008), 73 C.P.R. (4th) 470 (T.M.O.B.)]. This being said, I note that the Opponent seems to have attempted that exercise in each of its written arguments.

[36] I conclude from the Opponent's analysis that it is difficult to draw meaningful inferences about the state of the marketplace from the various business names and trade-names listed in the search report prepared by Ms. Aubin. Although a certain number of these business names or trade-names seem to be attached to restaurants, such as, for example, RESTAURANT LE TRIO INC., RESTAURANT LE TRIO LA BELLE PROVINCE, BUFFET TRIO INC. and BLACKVILLE TRIO PIZZA, it is impossible to determine the extent to which these names (a number of which seem to be referenced multiple times) have actually been used in Canada as trade-names at any time whatsoever, and still less the filing dates of the applications [see *Sparitual, LLC. v. Spa Ritual Corp.* (2011) T.M.O.B. 160 (CanLII)]. As well, although I can

conceive that the Opponent is not the only one using the word “TRIO” as a trade-name in association with food services in Canada, the evidence on file does not provide me with a basis for concluding that this word, as such, is in fact commonly used as a trade-name or trade-mark in association with food services in Canada.

[37] In sum, I agree with the Opponent that the evidence filed by way of Ms. Aubin’s affidavit, as presented, is of no significant assistance to the Applicant.

Instance of confusion

[38] The steps taken by Ms. Turnbull following the publication of the newspaper article referenced above as Exhibit “G” include a demand letter, dated October 12, 2006, sent to the Novotel Ottawa Hotel (Exhibit “H”). This letter, sent by the law firm Tierney Stauffer LLP, includes the following statements made on the Applicant’s behalf:

Numerous patrons have contacted, and continue to contact, my clients since the Ottawa Citizen article was published to enquire as to whether or not they are moving their location to Novotel or opening a second location.

[39] I am not prepared to give any weight to these statements, since the mere filing of such a demand letter does not constitute evidence of the allegations it contains.

Conclusion – likelihood of confusion

[40] As indicated above, the Applicant bears the legal onus of establishing, on a balance of probabilities, that its applications comply with the requirements of the Act. This onus on the Applicant means that, if a determinate conclusion cannot be reached once all of the evidence has been filed, the issue must be decided against the Applicant.

[41] Although the Opponent’s trade-name has a relatively low degree of inherent distinctiveness and is not the most original, the evidence on file leads me to conclude that this trade-name has become known in Ottawa to a certain extent. As well, in view of the Applicant’s argument, discussed above, regarding the tendency to abbreviate [see paragraph 30] and the evidence on file in support of such an argument [see paragraph 31], I conclude that the Applicant

has failed to establish, on a balance of probabilities, that a consumer having an imperfect recollection of the Opponent's trade-name TRIO would not be likely to infer that the wares and services described below and covered by each of the Applicant's applications for registration come from the same source or are otherwise related to or associated with the Opponent's bistro bar. In the absence of conclusive evidence about the state of the marketplace as regards the use of the word "TRIO" by third parties, I am in fact of the opinion that the differences between the Marks and the trade-name at issue are not determinative or sufficient in and of themselves to counterbalance the arguments above, and, in this regard, the balance of probabilities favours neither party. Since the legal burden is on the Applicant, I must find in favour of the Opponent. Consequently, I allow the ground of opposition argued on s. 16(3)(c) regarding the following wares and services described in each of the applications for registration:

menus; food services; restaurant, cafeteria, tea room, bar (with exception of clubs) services and dismiss the same ground regarding the rest of the wares and services, my opinion being that the differences between the remainder of the Applicant's wares and services and the Opponent's bistro bar tilt the balance of probabilities in the Applicant's favour.

Ground based on s. 16(3)(a) of the Act

[42] To discharge its initial burden of proof as regards this ground of opposition, the Opponent must show that its trade-mark TRIO was used or made known in Canada before the filing date of the applications, and that it had not abandoned use of this trade-mark at the date of advertisement of the applications [s. 16(5) of the Act].

[43] I am not satisfied that the Opponent has discharged its initial burden of proof in this regard. Although it is sometimes difficult to distinguish between use of a trade-name and use of a trade-mark, particularly in matters of services, and that such uses may not necessarily be mutually exclusive, I find that the Opponent's evidence on the use of the word TRIO as a trade-mark is somewhat ambiguous and vague in these files in that, except for the allegations set out in each statement of opposition, Ms. Turnbull never refers to a trade-mark by that name, but instead to the trade-name TRIO. The demand letter mentioned above (Exhibit "H") also refers only to the trade-name TRIO.

[44] Consequently, the ground of opposition based on s. 16(3)(a) of the Act is dismissed. I would add, in this regard, that if I am in error in refusing to recognize that the evidence in these files establishes the use of such a mark, this has no bearing on my ultimate decision in these files. The best the Opponent can hope for is that such a ground would be allowed only in part, in light of my analysis of the likelihood of conclusion made above regarding the ground of opposition argued on s. 16(3)(c) of the Act.

Ground based on non-distinctiveness

[45] To meet its initial burden of proof regarding non-distinctiveness, the Opponent must show that its bistro bar TRIO had become sufficiently known in Canada at the filing date of each of the statements of opposition in order to negate the distinctiveness of the Marks [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (C.F.); and *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

[46] In deciding this issue, I would like to reproduce certain passages from *Bojangles*, which guided me in my analysis:

33. The following propositions summarize the relevant jurisprudence on distinctiveness where there is an allegation that a mark's reputation negates another mark's distinctiveness, as per s. 2 and para. 38(2)(d) of the Act:

- The evidential burden lies on the party claiming that the reputation of its mark prevents the other party's mark from being distinctive;
- However, a burden remains on the applicant for the registration of the trade-mark to prove that its mark is distinctive;
- A mark should be known in Canada to some extent at least to negate another mark's distinctiveness;
- Alternatively, a mark could negate another mark's distinctiveness if it is well known in a specific area of Canada;
- A foreign trade-mark owner cannot simply assert that its trade-mark is known in Canada, rather, it should present clear evidence to that effect;

- The reputation of the mark can be proven by any means, and is not restricted to the specific means listed in section 5 of the Act, and it is for the decision-maker to weigh the evidence on a case-by-case basis.

In both the *Motel 6* and *Andres Wines* cases, the Courts noted that the evidence satisfied more than the jurisprudential requirement that the mark be known “to some extent at least” in Canada, and further mentioned that the mark was “well known” (*Andres Wines*). However, in order for an opposition to succeed, such a threshold need not be reached. The expression “well known” should be avoided in describing the legal test, as the courts expressly stated in *Motel 6* and *Andres Wines*. On the other hand, the expressions “substantial”, “significant” (*Bousquet v. Barmish Inc.*, above, pp. 528 and 529) and “sufficiently [known] to negate the distinctiveness of the mark under attack” (*Motel 6*, at para. 41) were never said to be wrong. In my view, these expressions give a clearer meaning to the expression “to some extent at least” and it should be adopted as a complement to the legal standard set down by the Federal Court in *Motel 6* (“to some extent at least”). Like Justice Cullen, I believe this to be a “salutary principle” (See *Bousquet v. Barmish Inc.*, above, at p. 528).

[47] As shown by my analysis above, although I am satisfied that the Opponent has demonstrated use of its trade-name TRIO in the city of Ottawa, the evidence on file provides me with no basis for determining to what extent the reputation attached to that trade-name may be characterized as sufficiently substantial and significant to negate the distinctiveness of the Marks. In the first place, I am not satisfied that the Opponent has discharged its initial burden of proof.

[48] Consequently, the ground of opposition argued on lack of distinctiveness is dismissed.

Ground based on s. 30(i) of the Act

[49] The relevant date for examining the circumstances surrounding noncompliance with s. 30(i) is the filing date of the applications [see *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 (T.M.O.B.)].

[50] In support of its allegations, the Opponent is relying on the copy of the demand letter, referenced above, appended to Ms. Turnbull’s affidavit (Exhibit “H”).

[51] This evidence of the Opponent merely establishes that a demand letter was sent to the Applicant before the filing date of the applications and that, as a result, the Applicant knew of the existence of the Opponent’s bistro bar TRIO. However, as the Registrar stated in reference to

a previous version of s. 30(i) in *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.), at page 155,

Section 29(i) merely requires “a statement that the applicant is satisfied” and in this case the application does contain such a statement. Taken in the context of s. 29 and in the light of the meaning of the word “statement” there would appear to be substance to the view that the mere inclusion of that statement in the application satisfies the requirement of para. (i). It may be felt that, if that is the correct view, para. (i) serves no useful purpose. However, even if that is the correct view, para. (i) may act as a deterrent to the would-be applicant whose conscience causes him to have a clear doubt about his right to use.

Unless there is evidence of bad faith on the part of the applicant, there would appear to be no case in which the allegation of confusion could not be more directly and more appropriately raised under either s. 37(2)(b) or (c). Even where there is evidence of bad faith, such evidence would be equally pertinent under those two paragraphs.

[52] In this case, there is no evidence of bad faith on the part of the Applicant. The mere fact that the Applicant received a demand letter is by no means inconsistent with the fact that, being of the opinion that the Marks do not lead to confusion with the Opponent’s bistro bar TRIO, the Applicant was satisfied that it was entitled to use the Marks as set out in its applications.

[53] Consequently, the s. 30(i) ground of opposition is dismissed.

Decision

Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse both of the applications for registration in respect of the following wares and services: “menus; food services; restaurant, cafeteria, tea room, bar (with exception of clubs) services” and I reject each

of the oppositions in respect of the rest of the wares and services, pursuant to s. 38(8) of the Act [on the issue of split decisions, see *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 492 (F.C.T.D.)].

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Trade-marks Opposition Board
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Certified true translation
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